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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,219	01/17/2002	Bernard Danner	1999CH006	9387

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CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

KUMAR, PREETI

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,219

Applicant(s)

DANNER ET AL.

Examiner

Preeti Kumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-20,23-26,40 and 41 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 18-20,23-26,40 and 41 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Final Rejection

Response to Amendment

1. Claims 18-20 and 23-26 and 40-41 are pending.
2. Claims 21-22 and 27-39 are canceled.
3. The rejection of claims 18-20 under 35 U.S.C. 103(a) as being unpatentable over Joyner et al. (US 4,483,969) is maintained for the reasons recited in the previous office actions and further explained below.
4. The rejection of claims 18-20, 23-26 and 40 under 35 U.S.C. 103(a) as being unpatentable over Miracle et al. (US 5,576,282) is maintained for the reasons recited in the previous office actions and further explained below. Regarding newly added claim 40, Miracle et al. teach conventional deterative adjuncts for treatment and/or modification of the textile such as with colorants or dyes. See col.11,ln.20-30.

Response to Arguments

5. Applicant's arguments filed October 27, 2005 have been fully considered but they are not persuasive.

Applicants urge that Joyner et al. fail to teach the moieties for use as the glycol in the first stage of a reaction of a dibasic acid and a glycol and not as endcapping moieties as recited by the instant claims.

Contrary to Applicants arguments, Joyner et al. teach end capped, functionalized polyester waxes useful in textile treatment. See col.1,ln.5-24. Applicants continued argument that the prior art is limited to polyfunctional end caps and the instant claims

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are limited to monofunctional endcaps is not found to be a patentable novelty as the prior art teaches the same as the encap moities recited by the instant claims.

Specifically Joyner et al. teach a polyester reacted with propylene glycol or ethylene glycol, (ln.13) with dicarboxylic acids or terephthalic acid (ln.4-5). See col.2, ln.4-18. Also, contrary to applicants arguments that the glycol taught by the prior art is not an endcapping moiety and the same glycol taught by the instant claims is an endcapping moiety, is not found persuasive because the prior art teaches that the reaction of a dibasic acid with a glycol results in a endcapped polyester. See col.2,ln.2-20 and example 1, ln.45-47.

Applicants urge that the teachings of Miracle et al. are to a disparate art which is not technically commensurate to the art in the claimed invention. Specifically, Miracle et al. teach a home laundry detergent and do not teach a lubricant in the manufacture of a textile.

Contrary to Applicants arguments the instant claims recite a method for treatment of a textile piece good from an aqueous liquor during pre-treatment, optical brightening or after-treatment. Examiner does not see how the language of the preamble limits the material limitation of the instant claim and further does not see how the preamble excludes a method of treatment of a textile with home laundry detergents. Miracle et al. teach treating textile with the same monomer end capped emulsifiable polyester to control and/or alter surface active properties and further teach this polyester in combination with a thickener in general to treat a textile. See the previous office actions and col.17,ln.15-20 and col.19, ln.54 and col.20,ln.58.

New Grounds of Rejection

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 18-20, 23-26 and 40-41 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Birbaum et al. (US 5,591,850).

Birbaum et al. teach polyester fibre material obtained by condensing terephthalic acid with ethylene glycol and further teach that said polyester fiber material may be dyed or printed in suitable closed vessels, such as a jet-dyeing machine. See col.6,ln.25-27 and col.6,ln.67-col.7,ln.2. Birbaum et al. teach xanthan thickeners. See col.19 line. 41.

The prior art, Birbaum et al., are silent as to the claimed properties of the polyester being encapped and do not explicitly teach the limitations of end-capping of the polyester with monofunctional adducts of ethylene oxide onto a C1-4 alkanol in a molar ratio of monofunctional adducts of ethylene oxide to glycols in the range from 0.04 to 0.3.

However, it is reasonable to presume that said limitations are encompassed by the invention of Birbaum et al. because the presumption is supported by the use of similar materials (i.e. ethylene glycol) and in the similar production steps (i.e. condensed with terephthalic acid) to produce the polyester. The burden is upon the applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594.

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In the alternative, the claimed encapped polyester would obviously have been provided by the process of condensing terephthalic acid with ethylene glycol as disclosed by Birbaum et al. because achieving the claimed encapped polyester having a ratio of monofunctional adducts of ethylene oxide to glycols in the range from 0.04 to 0.3 would be a matter of optimizing a result effective variable. It would be obvious to a person skilled in the art to modify the molar ratio of the ethylene oxide to glycols since Birbaum et al. suggest a broad range of 4-40 mols of ethylene oxide to 1 mol phenol and furthermore, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

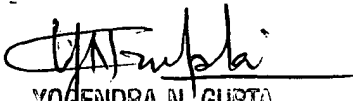
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Preeti Kumar whose telephone number is 571-272-1320. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Preeti Kumar
Examiner
Art Unit 1751

PK


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